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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/955,991	10/23/97	KORENBERG	P-CE-2017

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HM11/1221

EXAMINER
TUNG, H

ART. UNIT	PAPER NUMBER
1044	

DATE MAILED: 12/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/956,991

Applicant(s)
Korenberg

Examiner
Mary Tung

Group Art Unit
1644



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-30 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot Program. If you have any questions or suggestions, please contact Paula Hutzell, Supervisory Patent Examiner at paula.hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. Claims 1-10, 12, 20 and 30, drawn to an isolated and purified nucleotide sequence coding for said receptor, a vector, a host cell expressing said receptor, a process and method for detecting said polynucleotide by hybridization and PCR amplification of said nucleotide sequence, classified in class 536, subclass 23.5, class 435, subclasses 91.1, 325 and 320.1.
 - II. Claims 11 and 24, drawn to an antisense oligonucleotide, classified in class 536, subclass 23.1 and class 514, subclass 44.
 - III. Claims 13-19, drawn to a DS-CAM protein, classified in class 530, subclass 350.
 - IV. Claims 21-23, drawn to an antibody and composition, classified in class 530, subclasses 387.9, 388.2 and 389.1 and class 424, subclasses 139.1, 141.1.
 - V. Claims 25-27, drawn to a transgenic animal, classified in class 800, subclass 2.
 - VI. Claims 28 and 30, drawn to a method for identifying a nucleic acid, classified in class 435, subclass 6.
 - VII. Claim 29, drawn to a method for detecting a DS-CAM protein using an antibody, classified in class 435, subclass 7.1.
2. Groups I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product, the protein can be made using an amino acid synthesizer, for example.
3. Groups I-V are unique products. They differ with respect to their physicochemical properties and are therefore patentably distinct. The antisense oligonucleotide, recited

in Group II differs from the nucleic acid recited in Group I because the antisense oligonucleotide would encompass sequences containing non-natural nucleotide residues or nucleotide analogs (see the specification, page 24, line 33 and bridging over to page 25, line 11) such as sulfated or phosphonated backbone moieties, for example, and thus would not be capable of transcription or translation.

4. Groups VI and VII are unique methods. They differ with respect to ingredients and method steps. The method of identifying a nucleic acid, recited in Group VI would not suggest the method of detecting a protein, recited in Group VII. Thus, they are patentably distinct each from the other.
5. Groups I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the nucleic acid can be used in a diagnostic *in situ* hybridization assay, for example.
6. Groups III and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. 806.05(h)). In the present case, the product as claimed, the DS-CAM protein can be used as an antigen to raise antibodies in animals, for example.
7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and because a search of any or these three distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the Examiner, restriction for examination purposes as indicated is proper.
8. Applicant is further required under 35 U.S.C. 121:
9. To elect a **specific amino acid sequence**: SEQ ID NOS: 1, 2, 7, 8, 9, 10 or 11, if Group I is elected.
10. To elect a **specific amino acid sequence**: SEQ ID NOS: 1, 7, 8, 9, or 10, if Group VI is elected.
11. Applicant is required, in response to this action, to elect a specific embodiment to which the claims shall be restricted if no generic claim is finally held to be allowable. The

response must also identify the claims readable on the elected embodiment, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

12. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional embodiments which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected embodiment. MPEP § 809.02(a).

13. The following claim(s) are generic: claims 1, 13, 14, 20-27, and 29.

14. The species are distinct each from the other for the following reasons:

15. The sequences defined by SEQ ID NOS: 1, 2, 7, 8, 9, 10 and 11. They differ with respect to their structures and physicochemical properties and are therefore patentably distinct.

16. A telephone call was made to Laura A. Coruzzi on Dec. 6, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

17. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Conclusion

26. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). THE CM1 FAX CENTER TELEPHONE NUMBER IS (703) 305-3014 or (703) 308-4242.

26. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Mary Tung whose telephone number is (703)308-9344. The Examiner can normally be reached Monday through Friday from 8:30 am to 5:30 pm. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1640 receptionist whose telephone number is (703) 308-0196.

Serial No. 08/956,991

Art Unit 1644

Mary B. Tung
December 18, 1998

Mary B. Tung, Ph.D.

Patent Examiner

Group 1640

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David A. Saunders
DAVID SAUNDERS
PRIMARY EXAMINER
ART UNIT ~~182~~1644